

REMARKS**I. General**

Claims 1-13 and 15-18 are currently pending. Claims 1-18 are finally rejected by the present Office Action. No claims are amended by this response.

Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections in light of the arguments herein.

II. Amendments to the Specification

Applicant has added a new paragraph to page 1 of the Specification to include a reference to a related application to which the present application claims priority as indicated in the Utility Patent Application Transmittal submitted with the present application.

Applicant has amended a paragraph on page 2 of the Specification to correct a typographical error.

Applicant has amended a paragraph on page 6 of the Specification to delete extraneous text.

III. Amendments to the Claims

Applicant has amended claims 1 and 5 to simplify and clarify the claim language. No new matter is added by these amendments.

Applicant has added new claims 19-29. Support for the new claims is found at least on pages 4-7 and in Figures 1a, 1b and 2. No new matter is added to the application by the new claims.

IV. Improper Final Office - Claim 11 Not Addressed

Applicant submits that the present Office action is improperly made final because the Examiner has yet to identify the basis for a rejection of claim 11. Although indicated as rejected in the Office Action Summary, claim 11 is not specifically addressed within the body of the present Office Action and no prior art has been cited against claim 11. Accordingly, the rejection of claim 11 does not comport with the requirement that "notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given." M.P.E.P. § 707.

The Examiner has not clearly articulated a rejection for claim 11 and, therefore, Applicant has not had an opportunity to provide evidence of patentability or otherwise respond completely to rejection of the application. See M.P.E.P. §706. Applicant requests that the Examiner withdraw the finality of the present Office Action and issue a new non-final Office Action that sets forth the grounds for rejection with respect to claim 11 in order that Applicant may have a full and fair opportunity to explore the patentability of this claim.

V. Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1, 2, 5, 6, 9, 10, and 13-16 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,742,905 to Pepe *et al.* (hereinafter “Pepe”). Applicant traverses the rejections based upon the Pepe reference.

A. Claims 1-8 are allowable over Pepe

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989)).

Claims 1 and 5 require the element “adapted . . . to alert the subscriber when a characteristic match is found.” This feature is not taught by the Pepe reference. The cited sections of Pepe (i.e. columns 4 and 34 listed in Office Action paragraph 4) disclose that an alert notification is sent for all e-mail messages. Instead of teaching that a subscriber is alerted when “a characteristic match is found,” Pepe teaches notification for all messages and does not include any disclosure of distinguishing among messages before sending a notification.

In paragraph 14 of the present Office Action, the Examiner has further cited column 26, line 65 through column 27, line 5 of Pepe as teaching this feature. However, the cited passage only describes matching the subject field of an e-mail to a screening list. Pepe does not teach that this matching function is coupled to an alert or notification feature as required in claims 1 and 5.

Furthermore, in paragraph 15 of the Office Action, the Examiner appears to admit that Pepe does not teach this alert feature.

Dependent claims 2 and 6 each depend directly from respective independent claims 1 and 5 and, thus, inherit all the limitations of the respective independent claims. Accordingly, because of their dependence from base claims 1 and 5, dependent claims 2 and 6 are allowable at least for the reasons discussed above. Applicant respectfully requests that the rejection of claims 1, 2, 5, and 6 under 35 U.S.C. §102 be withdrawn and those claims passed to issue.

B. Improper § 102(e) Rejection of Claims 5, 9 and 13.

In paragraph 5, of the Office Action, the Examiner merely states that “Claims 5, 9, and 13 fail to teach or define above or beyond claim 1, and are rejected for the reasons set forth above.” The Examiner has improperly ignored the elements of claims 5, 9 and 13 that are not found in claim 1. For example, the Examiner has not addressed the “Mail Alert system” of claim 5 (which does not require the “Mail Alert code set” of claim 1), the “prerecording” step of claim 9, or the “stored list” element of claim 13, among other elements of claims 5, 9 and 13 that differ from claim 1.

In paragraph 17 of the Office Action, the Examiner has incorrectly states that claims 5 and 9 recite the specific limitations argued by Applicant regarding claim 1. Moreover, even if some elements appear in more than one claim, the Examiner’s response continues to ignore the features of claims 5, 9 and 13 that are not found in claim 1.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 5, 9 and 13 and provide a rejection that identifies where the elements of those claims can be found in the prior art so that applicants may fully and properly respond. See M.P.E.P. § 707.07.

C. Claims 9-12

Claim 9 requires “forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert.” Pepe does not teach the above-recited feature of claim 9.

The Pepe reference teaches that when an email is received, the PCI server checks the subscriber’s profile, and then directs the delivery and notification according to the profile. See Pepe, col. 25, lines 60-67. Pepe does not teach “forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert,” as

required by claim 9. E-mail delivery in Pepe is not done in response to an alert. Instead, e-mail delivery is performed according to preselected criteria. The use of “preselected criteria” does not disclose the “in response to an alert” feature. Therefore, Pepe does not teach each and every element of claim 9.

Further, claim 9 requires “alerting the subscriber to the receipt of one or more messages for which a characteristic match is found.” Pepe does not teach this feature of claim 9.

The Pepe reference discloses a notification that an email has been received - without regard for a characteristic match. Therefore, Pepe does not teach each and every element of claim 9.

Claims 10-12 depend directly from independent claim 9 and, thus, inherit all the limitations of claim 9. Accordingly, dependent claims 10-12 are allowable at least for the reasons discussed above. Applicant respectfully requests that the rejection of claims 9-12 be withdrawn and those claims passed to issue.

D. Claims 13, 15-18

Claim 13 requires “an alert mechanism for alerting a subscriber to the receipt of messages having characteristics matching the stored characteristics.” Pepe does not teach this feature of claim 13.

As discussed above, Pepe teaches a notification that an email has been received, but does not teach that the notification is associated with or triggered by characteristic matching. Thus, Pepe does not teach each and every element of claim 13.

Claims 15-18 depend directly from independent claim 13 and, thus, inherit all the limitations of claim 13. Accordingly, dependent claims 15-18 are allowable at least for the reasons discussed above. Applicant respectfully requests that the rejection of claims 13, 15-18 be withdrawn and those claims passed to issue.

VI. Rejections Under 35 U.S.C. §103

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success.

Finally, the applied reference must teach or suggest all the claim limitations. M.P.E.P. § 2143. Without conceding any other criteria, Applicants respectfully assert that the rejections under § 103(a) do not satisfy the third criterion, as discussed further below.

A. Rejections in view of Pepe as modified by the Examiner

The Examiner has rejected claims 4, 8, 12, and 18 under 35 U.S.C. § 103(a) as being obvious over Pepe. Applicant traverses the rejection.

As discussed above, Pepe does not teach all of the elements of claims 1, 5, 9, and 13. Dependent claims 4, 8, 12, and 18 depend either directly or indirectly from respective base claims 1, 5, 9, and 13 and, therefore, inherit all of the limitations of their respective base claims. Therefore, Pepe does not teach or suggest all of the limitations of dependent claims 4, 8, 12, and 18. Accordingly, dependent claims 4, 8, 12, and 18 are allowable at least because of their dependence from respective base claims 1, 5, 9, and 13 for the reasons discussed above.

B. Rejections in view of the Pepe/Fuller combination

The Examiner rejected claims 3, 7, 12, and 17 under 35 U.S.C. §103(a) as being obvious over Pepe in view of Fuller. Applicant traverses the rejection.

As discussed above, Pepe does not teach all of the limitations of independent claims 1, 5, 9, and 13. Claims 3, 7, 12, and 17 depend either directly or indirectly from respective base claims 1, 5, 9, and 13 and, thus, inherit all of the limitations of their respective base claims. Therefore, Pepe does not teach or suggest all claim limitations of claims 4, 8, 12, and 18.

The Examiner does not rely on Fuller to teach or suggest the limitations of claims 1, 5, 9 and 13 that are missing in Pepe. Fuller discloses a system and method to manage a phone call and does not teach or suggest the limitations missing from the independent claims. Thus, the cited combination of Pepe and Fuller does not teach or suggest all claim limitations of claims 3, 7, 12, and 17. Accordingly, dependent claims 3, 7, 12, and 17 are allowable at least because of their dependence from respective base claims 1, 5, 9, and 13 for the reasons discussed above.

VII. New Claims

Applicants have added new claims 19-29. Independent claim 19 requires:

if the message matches the criteria, then sending an alert to the subscriber;
receiving a reply from the subscriber in response to the alert, the reply comprising instructions for the message; and
processing the message according to the instructions.

As discussed above, Pepe does not teach sending an alert to a subscriber when a message matches criteria. Furthermore, Pepe does not teach receiving a reply to such an alert or that the reply includes instructions regarding how to process the message, as required in the claim. Therefore, new claims 19-29 are allowable over the cited art of record and should be passed to issue.

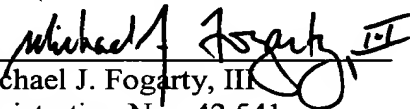
VIII. Conclusion

In view of the above remarks, each of the pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

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Respectfully submitted,

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